

Appl. No. 10/678,023
Reply to Office Action of September 4, 2007

PATENT

REMARKS/ARGUMENTS

Specification

In the specification, paragraph [0099] has been amended to include the SEQ ID numbers for the sequences supplied in the "Response to Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures" filed Nov. 30, 2006.

Final Restriction

The examiner has maintained the restriction as final because "Group II requires an additional search". The examiner has not provided a response to applicant's argument citing the MPEP wherein separate classification alone does not constitute restriction nor an undue burden. The MPEP cites that classification **and** field of search are the determining factors (see MPEP 808.02(A)(C)). Divergent classification may exist within the same field of search (emphasis added). As cited previously by applicant, the transformed Guayule of Group II is specifically obtained via the process set forth in Group I, resulting in shoot elongation and rooting, as such the field of search of the transformed product would necessarily include the method which confers certain features to the plant. Reconsideration of the finality of the restriction requirement is respectfully requested.

Claim Objections

The examiner has objected to claims 1, 4 and 10 as containing informalities. Applicant respectfully acknowledges that the amendment suggested by the examiner presents a substantive matter (MPEP 706.03), which applicant will reply to should the claims be treated as such. Applicant respectfully asserts that one of skill in the art would know that rooting has occurred given that the claim recites the production of a transformed plantlet (which as acknowledged by the examiner requires rooting) as well as the teachings of the instant specification (p. 15,[085]).

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Claim Rejections

(a) 35 U.S.C. §102 – The statute is cited for 35 USC §102 however, the examiner has not indicated any claims as being rejected under 35 USC §102.

(b) (a) 35 U.S.C. §103(a) – Claims 1, 4, 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hallahan et al., U.S. 6, 645,747 (Hallahan).

The examiner suggests that “although Hallahan et al does not explicitly teach Guayule, Guayule is a plant suitable for transformation with the methods disclosed”. However, the method disclosed by Hallahan requires the use of cocultivation of the *Agrobacterium* species *tumefaciens* and *rhizogenes*. This cocultivation step is not analogous to the invention as claimed; specifically, Hallahan teaches away from the claimed invention as the *Agrobacterium* (ATCC 15834) possessing the target gene is incubated in continuous dark conditions (emphasis added), see col. 23, lines 64 – 67, not the claimed controlled light conditions. The use of the “cool white fluorescent lamps” as cited by the examiner occurs with an *Agrobacterium* strain (LBA4404) that does not have a target gene present (see col. 23, lines 54 -55), which also teaches away from the invention as claimed.

The examiner’s motivation that “dipping leaf strips is easier” suggests that the invention is limited in scope to a “dipping process” and excludes critical elements of the claim(s) to accomplish the transformation of Guayule. The examiner has failed to establish a *prima facie* case of obviousness with regard to how one of skill in the art would be motivated to use a single *Agrobacterium* species to achieve transformation using the cocultivation teachings of Holland; particularly, when opposite the claimed invention, the *Agrobacterium* species of Holland possessing the target gene (ATCC 15834) is incubated under continuous darkness without exposure to controlled light/fluorescent lamps.

For the reasons cited above, withdrawal of the rejection(s) of record is respectfully requested.

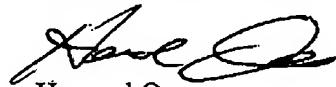
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CONCLUSION

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 510-559-5731.

Respectfully submitted,



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